

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Larry Lunetta et al. Examiner: Cuong H. Nguyen
Serial No.: 09/930,676 Group Art Unit: 3661
Filed: August 14, 2001 Docket No.: 2047.001US6
Title: METHOD AND APPARATUSES FOR GENERATING COMPOSITE IMAGES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed February 15, 2006, Applicants request review of the rejections in the above-identified Application. Applicants respectfully traverse all rejections of the claims in the above mentioned Final Office Action. No amendments are submitted with this Request, which is being filed with a Notice of Appeal for the reasons stated below. The review is requested because it is believed that *prima facie* obviousness has not been established in the rejections of the claims for at least the reasons stated below.

§103 Rejection of the Claims

Claims 1-2, 10-11, 13, 19, 24-25, and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman (U.S. 4,931,929) in view of Halliday et al. (U.S. 5,880,740).

Applicants respectfully traverse the rejection of claims 1-2, 10-11, 13, 19, 24-25, and 61 and submit that *prima facie* obviousness has not been established because the proposed combination of Sherman and Halliday et al. fails to teach or suggest each of the elements included in claims 1-2, 10-11, 13, 19, 24-25, and 61.

As shown by Applicants' arguments presented on pages 10-13 of Applicants' response to a previous Non-final Office Action in the application, the Non-final Office Action mailed June 8, 2005 (Applicants' response mailed October 6, 2005; hereinafter "Applicants' Response"), claims 1 and 61 both recite,

generating a user interface that facilitates input of specification information concerning the promotional product, the specification information including product information identifying a base product to be decorated and decoration manufacturing process information identifying a process whereby a decoration is applied to the base product;

receiving the specification information concerning the promotional product. [Emphasis added].

In contrast, Sherman at column 8, lines 40-43 states, "a user of the present inventive system specifies a product type and is then provided with a list of predetermined categories of characteristics for that product type. The user then selects one or more desired characteristics." As quoted on page 11 in Applicants' Response, characteristics in Sherman are described in column 7, line 67 through column 8, line 12. However, as stated on page 11 of Applicants' Response, there is no teaching or suggestion of a user interface that facilitates input of specification information including product information identifying a base product and decorating manufacturing process information identifying a process whereby a decoration is applied to the base product. Thus, Sherman fails to teach or suggest all of the elements recited in claims 1 and 61.

The Final Office Action on page 3 states that these elements are "merely non-functional descriptive material that do not contribute to a claimed step in pricing a product." Applicants respectfully disagree. The recitation of "product information identifying a base product to be decorated and decoration manufacturing process information identifying a process whereby a decoration is applied to the base product" as recited in both claim 1 and claim 61, represent types of specific information, the input of which is facilitated by a user interface, and therefore are elements included in claims 1 and 61 that are not recited in Sherman.

Further, claims 1 and 61 both recite, "automatically calculating a price for the promotional product utilizing the product information and the decoration manufacturing process information." Since Sherman fails to teach or suggest decoration manufacturing process information, it follows that Sherman also fails to teach or suggest automatically calculating a price for the promotional product utilizing the decorating manufacturing process information, as recited in claims 1 and 61. With respect to these elements, the Final Office Action on page 4 states these elements are, "merely non-functional descriptive material that do not distinguish from prior art because they do not contribute to core steps of pricing a product, including decoration charges as extra optional practices." [Emphasis added]. Again, Applicants respectfully disagree with these statements, and further, submit that "contribution to core steps" is not the proper standard by which the obviousness of a claim is determined.

Despite this, the Final Office Action fails to point out in Sherman a teaching or suggestion of all of these claim elements recited in claims 1 and 61. In fact, the Final Office

Action on pages 3-4 admits that Sherman fails to disclose automatically calculating a unit price for the promotional product utilizing the product/pattern information and decoration manufacturing process information, but relies on Halliday et al. as providing these elements admittedly missing from Sherman. However, as pointed out on pages 12-13 of Applicants' Response, Halliday et al. at column 7, lines 15-23 merely states,

The workstation 101 consists of a conventional personal computer 111 provided with local read/write disk storage, such as a hard disk drive, at 113 and a CD-ROM player 115, both of which store individual image elements used to form composite images. A mouse 117 is connected to provide positional, zone selecting input signals to the computer 111 which displays the composite images on a conventional CRT display device 121. A keyboard 123 is used to accept text input and command from the user.

Applicants' representatives cannot find, and the Final Office Action does not point out in Halliday et al., a teaching or suggestion of a user interface that facilitates input of specification information including decorating manufacturing process information identifying a process whereby a decoration is applied to the base product, as recited in claims 1 and 61. Further, it logically follows that there is no teaching or suggestion in Halliday et al. of "automatically calculating a price for the promotional product utilizing the product information and the decoration manufacturing process information," as also recited in claims 1 and 61. In fact, Applicants' representatives cannot find a teaching or suggestion in Halliday et al. of calculating a price whatsoever, as suggested in the Final Office Action.

Thus, because neither Sherman nor Halliday et al., either alone or in combination, teach or suggest all of the elements recited in claims 1 and 61, the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 1 and 61. Claims 2, 10-11, 13, 19, and 24-25 depend from claim 1, and therefore include all of the elements recited in claim 1. For reasons analogous to those stated above with regards to claim 1, the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 2, 10-11, 13, 19, 24-25.

For at least the reasons stated above, Applicants respectfully submit that *prima facie* obviousness has not been established with respect to the rejection claims 1-2, 10-11, 13, 19, 24-25, and 61. Reconsideration and reversal of the rejections of claims 1-2, 10-11, 13, 19, 24-25, and 61 is therefore respectfully requested.

Claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30

Claims 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman in view of Halliday et al., in view of Goldberg et al. (U.S. 6,196,146), and in view of Mikurak (U.S. 6,606,744).

Claims 8-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman in view of Halliday et al., and further in view of Schwab (U.S. 6,226,412).

Claims 3-7, 10, 12, 14-18, 20-23, 26 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sherman in view of Halliday et al., in view of Goldberg et al.

As stated on pages 13-14 of Applicants' Response, claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30 have been rejected based on the various combinations of references as stated above. Each of these claims depend from claim 1 of the application, and therefore include all of the elements recited in claim 1. In each of the above rejections, the Final Office Action relies on the rationales and references in rejecting claim 1, specifically the proposed combination of Sherman and Halliday et al., as supplying the elements recited in claim 1. Applicants believe they have established that the proposed combination of Sherman and Halliday et al. does not teach or suggest all of the elements recited in claim 1. Further, the Final Office Action fails to point out in any of the other cited references where the elements recited in claim 1 and missing from Sherman and Halliday et al. are taught or suggested by any of these other references.

Therefore, each of the proposed combinations of references fails to teach or suggest all of the elements recited in claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30, as the proposed combinations of references are applied to these claims. Since each of the proposed combinations of references fails to teach or suggest all of the elements recited in claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30 as the rejections are applied to the claims, the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30.

For at least the reasons stated above, Applicants respectfully submit that *prima facie* obviousness has not been established with respect to the rejection claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30. Reconsideration and reversal of the rejections of claims 3-7, 8-9, 10, 12, 14-18, 20-23, 26, 27-29, and 30 is therefore respectfully requested.

CONCLUSION

In conclusion, Applicants respectfully submit that *prima facie* obviousness has not been established in the Final Office Action for at least the reasons stated above with respect to claims 1-30 and 61, and further, that these claims are in condition for allowance. Reversal of the rejections and an indication of allowance of claims 1-30 and 61 is earnestly requested. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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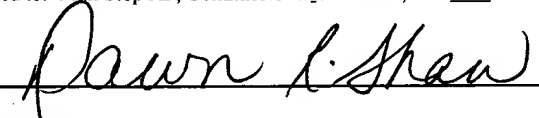
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15 day of June 2006.

Dawn R. Shaw

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